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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/121,725	07/24/1998	ERNEST A. VOISIN	V98-1054	3626

7590 10/30/2003

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EXAMINER	
BECKER, DREW E	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/121,725	VOISIN, ERNEST A.	
	Examiner	Art Unit	
	Drew E Becker	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,4,6,7 and 27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,4,6,7 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. The declarations under 37 CFR 1.132 filed October 9, 2003 is insufficient to overcome the rejection of claims 3-4, 6-7, and 27 based upon JP 4356156A and Tesvich et al as set forth in the last Office action because: the declarations of Mr. Chauvin, Mr. Voisin, Mr. Sunseri, and Mr. Nelson argue that JP 4356156A did not inherently teach elimination of bacteria. However, although JP 4356156A does not recite an effect upon pathogenic Vibriones bacteria, this would have inherently occurred. The method steps utilized in the reference are the same as those instantly claimed, and thus one of ordinary skill in the art would have expected the same results. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. This conclusion was also affirmed by the Board of Patent Appeals and interferences in its decision of March 10, 2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 4356156A.

JP 4356156A teach a method of treating shellfish comprising exposing raw oysters (paragraph 0005) contained in plastic bags filled with sea-water (paragraph 0010) to hydrostatic pressures of 14,615-44,087 psi for 0.5-10 minutes at ambient temperatures without heating, thermal damage, or mechanical damage (paragraph 0006). Although JP 4356156A do not recite an effect upon pathogenic Vibriones bacteria, this would have inherently occurred. The method steps utilized in the reference are the same as those instantly claimed, and thus one of ordinary skill in the art would have expected the same results. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. Further, it was known that high pressure treatment of seafood destroyed pathogenic organisms such Vibrio, as evidenced by Cheftel [Effects of high hydrostatic pressure on food constituents: an overview] (page 204, heading 1.2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4356156A in view of Tesvich et al [Pat. No. 5,773,064].

JP 4356156A teaches the above mentioned concepts. JP 4356156A does not recite retaining the treated shellfish at below ambient temperature or the use of bands. Tesvich et al teach a method of processing shellfish by banding them (Figure 1, #18) and then refrigerating the treated shellfish (column 2, lines 53-56). It would have been obvious to one of ordinary skill in the art to incorporate the refrigerated storage of Tesvich et al into the invention of JP 4356156A since both are directed to methods of processing shellfish, since the pressure treated shellfish of JP 4356156 were raw and uncooked, and since storing raw, uncooked foods at refrigeration temperatures was a common method of preservation, as shown by Tesvich et al. It would have been obvious to one of ordinary skill in the art to incorporate the bands of Tesvich et al into the invention of JP 4356156A since both are directed to methods of treating shellfish, since JP 4356156A already included placing the shellfish into plastic bags filled with seawater (paragraph 0010) as well as the opening of the shellfish during pressurization (paragraph 0009), and since the bands of Tesvich et al kept the shells from opening during processing, provided advertising logos and other indicia which would better promote the product to the consumer, and also provided evidence of tampering (column 6, lines 36-64).

Response to Arguments

6. Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive.

The declarations under 37 CFR 1.132 filed October 9, 2003 is insufficient to overcome the rejection of claims 3-4, 6-7, and 27 based upon JP 4356156A and Tesvich et al as set forth in the last Office action because: the declarations of Mr. Chauvin, Mr. Voisin, Mr. Sunseri, and Mr. Nelson argue that JP 4356156A did not inherently teach elimination of bacteria. However, although JP 4356156A does not recite an effect upon pathogenic Vibriones bacteria, this would have inherently occurred. The method steps utilized in the reference are the same as those instantly claimed, and thus one of ordinary skill in the art would have expected the same results. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. This conclusion was also affirmed by the Board of Patent Appeals and interferences in its decision of March 10, 2003.

The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 703-305-0300. The examiner can normally be reached on Monday-Thursday 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

Drew E Becker
Examiner
Art Unit 1761

10-27-03